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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 82300KNM

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on September 13, 2005

Signature Karen J Wacenske

Typed or printed name Karen J. Wacenske

Application Number	Filed
09/942,241	08/29/2001

First Named Inventor: Olivier J. Poncelet

Art Unit	Examiner
1634	Betty J. Forman

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [X] attorney or agent of record. Registration number 40,101
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

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Telephone number

9/13/2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

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PRE-APPEAL BRIEF REQUEST FOR REVIEW
- Expedited Examining Procedure -
Examining Group 1634

MAIL STOP AF
82300KNM
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Krishnan Chari, et al.

RANDOM ARRAY OF MICROSPHERES

2nd RCE of U.S. Serial No. 09/942,241
filed 29 August 2001

Group Art Unit: 1634

Examiner: Betty J. Forman

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Karen J. Wacenske

9/13/05
Date

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request pre-appeal brief review of the Final Office Action dated 21 June 2005, in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The claims are as set forth in the response filed 4 April 2005, with claims 1-24, 26-28, 30-34, and 43 pending; claims 44-46, 48, and 49 withdrawn from consideration, and claims 41 and 42 not entered.

The terms "bead" and "microsphere" are used herein interchangeably.

Rejection of Claims 1-8, 13, 15-17, and 21 Under 35 U.S.C. §102(b) over Sutton et al.

Claims 1-8, 13, 15-17, and 21 are rejected under 35 U.S.C. §102(b) over Sutton et al., U.S. Patent 5,714,340.

Claim 1 is an independent claim from which the remainder of the rejected claims depend. Claim 1 is directed to a coating composition consisting of a single layer of microspheres randomly dispersed with a uniform density in a fluid on a substrate, wherein the fluid contains a gelling agent that forms an immobilizing gel. Sutton et al. does not teach (1) a single layer of microspheres having a random distribution, or (2) use of a gelling agent that forms an immobilizing gel.

Sutton et al. teaches two bead layers, the first being a bead spreading layer having a stack of beads (see col. 9, lines 59-63, and Fig. 1), and the second being a receptor bead layer formed in clusters (see col. 10, lines 1-7, and Figs. 3-5), as discussed in Applicants' arguments submitted April 4, 2005 (pages 8-9), November 10, 2004 (pages 8-9), and May 4, 2004 (pages 10-11). The receptor bead layer relied on by the Patent Office clearly shows agglomeration and a non-random distribution (as random is defined by Applicants) in Figs. 3-5, as admitted by Examiner Forman in the telephonic interview of April 23, 2004, and recorded in Applicants' remarks in the paragraph bridging pages 10 and 11 of the Amendment filed May 4, 2004. This is demonstrated in Applicants' example 2, wherein formulation two corresponds to Sutton et al., and results in streaks caused by aggregation of the beads in a non-Poisson distribution (see pages 11-12 of the specification, and corresponding Figs. 4A-5B).

As shown in Applicants' Example 2, at least class II of the specific receptor zone coating polymers disclosed by Sutton at col. 6, line 55, - col. 7, line 21, does not form an immobilizing gel, resulting in non-random distribution of beads, that is, agglomeration or clustering of beads in the polymer. One skilled in the art would expect the disclosed classes provided by Sutton et al,. to act similarly. Thus, the demonstration that class II, poly(vinyl alcohol), does not immobilize beads or microspheres rebuts the presumption, without further explanation by the Patent Office, that Sutton et al. discloses an immobilizing gel.

As set forth above, the final rejection is clearly in error because Sutton et al. does not teach all the elements of the claimed invention.

Rejection of Claims 1-24, 26-28, 30-34, and 43 Under 35 U.S.C. § 102(b) over Pierce et al.

Claims 1-24, 26-28, 30-34, and 43 are rejected under 35 U.S.C. §102(b) over Pierce et al., U.S. Patent 4,258,001.

A prima facie case of obviousness has not been established because Pierce et al. does not disclose every element of the claimed invention. In particular, Pierce et al. does not teach a single layer of microspheres as required by both independent claims 1 and 27, from which all other rejected claims depend. As set forth in Applicants' responses of April 4, 2005 (pages 9-10), November 10, 2004 (page 10), and May 4, 2004 (page 11), Pierce et al. is directed to a three-dimensional structure, and teaches away from a two-dimensional structure. It is clear from all the figures,

including Fig. 3 cited on page 12 of the final Office Action dated June 21, 2005, that Pierce et al. forms a single layer having a thickness formed by more than one microsphere, that is, a single layer containing a three-dimensional array of microspheres, not a single layer of microspheres in a fluid or gel, as claimed by Applicants.

As set forth above, the final rejection is clearly in error because Pierce et al. does not teach all the elements of the claimed invention.

Rejection of Claims 1, 2, 4, 9-12, 15-17, 21-23, 26-28, 30, 31, 33, 34, and 43 Under 35 U.S.C. §102(e) over Chari et al.

Claims 1, 2, 4, 9-12, 15-17, 21-23, 26-28, 30, 31, 33, 34, and 43 are rejected under 35 U.S.C. § 102(e) over Chari et al. (U.S. Patent 6,599,668).

A prima facie case of obviousness has not been established because Chari et al. does not teach every element of the claimed invention. In particular, Chari et al, is directed to a method of forming a color filter array on a surface by applying a dispersion of randomly disposed colored beads on the surface, wherein the dispersion itself forms the color filter array. Chari et al. does not teach the use of a coating aid in forming the color filter array dispersion. Applicants' independent claims 1 and 27, from which all other rejected claims depend, require a coating aid. Further, claim 27 is directed to a microarray, which term is critical to the claim, and is not a mere preamble to be ignored. Chari et al. does not teach a microarray.

As set forth above, the final rejection is clearly in error because Chari et al. does not teach at least use of a coating aid, or a microarray.

Rejection of Claims 1, 2, 4, 9-12, 15-17, 21-23, 26-28, 30, 31, 33, 34, and 43 for Double Patenting over Chari et al.

Claims 1, 2, 4, 9-12, 15-17, 21-23, 26-28, 30, 31, 33, 34, and 43 are rejected for obvious-type double patenting over claims 1-8, 15, 16, and 19 of Chari et al. (U.S. Patent 6,599,668).

With regard to claim 1 and the claims dependent therefrom, Applicants claim a coating, while Chari et al. is directed to a method of making a color filter. A practitioner in the field of coatings would not look to art describing the manufacture of a color filter for a teaching of how to form a single layer, random array coating.

As argued elsewhere herein with regard to claim 27 and the claims dependent therefrom, the term "microarray" is critical to define the claimed

invention. Chari et al. does not teach or disclose a microarray. Rather, Chari et al. claims a method of forming a color filter array. Color filter arrays are an entirely different field of art from microarrays. A practitioner forming a microarray would not examine color filter art for ideas or motivation. Thus, Applicants' claimed invention is distinct over the cited art.

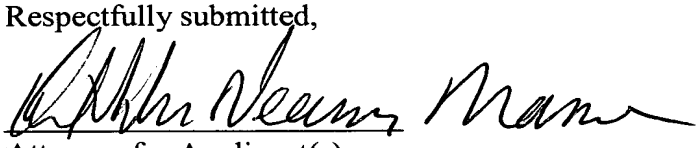
Although Applicants submit that the claimed invention is distinct from the claimed color filter array of Chari et al., Applicants submit that Chari et al. was commonly owned at the time the claimed subject matter of the application was invented, and would be willing to submit a Terminal Disclaimer to further prosecution if this were the only remaining issue barring allowance of the application.

Claims 44-46, 48 and 49

Claims 44-46, 48, and 49 are withdrawn from consideration. These are method claims that either depend from claim 1 (claim 49), or include all of the features of claim 1 (claims 44-46 and 48). These claims appropriately should have been considered with claim 1 and the claims dependent therefrom. Applicants submit these claims are patentable over the applied art for at least the same reason as claim 1. Consideration of the withdrawn claims is in order.

For at least the reasons set forth above, Applicants submit the rejections should be withdrawn, and the application passed to issue. A prompt and favorable action in response to this request is earnestly solicited.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.